

## REMARKS

The Office Action dated October 18, 2007 has been received and carefully noted. The above amendments and the following remarks are being submitted as a full and complete response thereto. Reconsideration and allowance are respectfully requested.

Prior to entry of this amendment, claims 1-21 were pending in the application.

By this amendment, claim 1 has been amended in order to overcome claim rejections under 35 U.S.C. 102 and 103, claims 5 and 6 have been deleted for consistency with amended claim 1 and new claims 22 and 23 have been added.

Applicant respectfully submits that no new matter is presented herein.

Support for the amendments to claim 1 and for new claims 22 and 23 were already disclosed in the specification as originally filed.

### **Claim Rejections - 35 U.S.C. 102**

Claims 1, 2, 5, 6 and 11-14 have been rejected under 35 U.S.C. 102(b) as being anticipated by Goros (US 2,968,560). By this amendment, Applicant has amended claim 1 by introducing some features originally disclosed in claims 5 and 6.

Now claim 1 specifies that at least the top of the capsule is covered by a removably sheet of protective material and that the flexible first container comprises a pod made of filter paper or other similar filter material placed inside the second container. Claim 1 is therefore novel, since none of the cited prior art shows such features.

Indeed, Goros shows an infusion package comprising a frangible body separated into a first and second compartment by a porous separator (col 1 lines 55-58). Therefore Goros does not disclose a first container and a second container but, instead, a first and a second compartment in the same container.

In particular, the infuser of Goros comprises a cup-like body 12 having a bottom wall 14 which extends flat in plane. A porous disk 20 separates the body into two compartments 22 and 24. A metered amount of a dehydrated dairy product is contained within compartment 22 and a metered amount of ground coffee is contained within compartment 24 (col 2 16-20).

Therefore, Goros does not show that the first compartment 24 is flexible and that it comprises a pod made of filter paper or other similar filter material placed inside the second compartment. By contrast, the first compartment 24 is simply a portion of the frangible body 12, delimited on the top by a closure 26 and on the bottom by the porous disk 20.

In the present application the entire first container is made of flexible material, and in particular is a pod (therefore a sort of closed bag) made of filter paper or other similar filter material. Moreover this pod is placed inside the second container.

By contrast, Goros shows that the first compartment is placed above the second, and not within it. A closure is placed across the filling opening of the body. The closure is then hermetically sealed to the annular flange (col. 2, lines 23-29). The closure 26 is not removably placed on the top of the infuser as it is, by contrast, in the present application. Indeed, as shown in figure 4 of Goros, piercing means 40 pierce on the upper section of the infuser to provide a passage for the infusion liquid therethrough. The closure is not removed before placing the

infusion package into the automatic vending machine.

New claim 22 is also novel since Goros does not disclose, as already explained, a first container and a second container but a first and a second compartment in the same container. Moreover Goros does not show that the first compartment is made of flexible material. Further, the bottom surface of the second compartment of Goros does not have a hole covered by a seal as specifically claimed. Indeed, the bottom surface of the second compartment of Goros is a plane flat surface 14 which does not presents any hole covered by any seal. Moreover, the bottom surface of Goros is pierced by piercing means, but once pierced, the holes which have been formed cannot be re-closed. Therefore, claim 22 is novel.

New claim 23 is novel. Indeed, Goros does not show, as already explained, a first compartment comprising a pod made of filter paper or other similar filter material, and a rigid second container comprising a cartridge made of a food safe plastic material. Moreover, Goros does not disclose any pod which presents an annular outer edge fixed to a matching annular protuberance on the plastic cartridge, at the top of the cartridge itself. Indeed, the porous disk 20 of Goros, which physically separates the two compartments 22 and 24, is placed inside the container 12, nearer the bottom wall 14, and has a perimetric circular edge in contact with the internal side walls 16 of the container 12. In other words, the separator is cut with the same diameter as the inside of the side wall of the container 12.

### **Claim Rejections - 35 U.S.C. 103**

Claims 3, 4, 7-10 and 15-21 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Goros in view of Nelsen (US 3,199,437).

Applicant respectfully traverses the Examiner's opinion about the combinability of Goros with Nelsen.

Nelsen discloses an infusion apparatus, which cannot be used with an espresso coffee machine.

Nelsen discloses an apparatus for making cold water coffee infusion, and not hot infusion as it is obtained with an espresso coffee machine.

The apparatus of Nelsen comprises an outer plastic tube like container 10 dimensioned to receive an inner container 22, made of felted cotton or porous material, which holds coffee, barks, roots, leaves, beans or other material to be extracted (c 2 l. 25-27). No mention to powdered milk or creamer, or to two products to be mixed to obtain the desired beverage is made. The outer container is sealed on the top and on the bottom. No removable cover is present.

The outer container is filled with cold water. Near the apex of the peaked top of the outer container there is an area adaptable for cutting (and not for being removed!) along a guide line, in order to provide an opening for use first in filling the container with cold water, and then for discharging the infusion resulting from the extraction (c. 2 l. 6-11). A plurality of projections 24 and 26 extending inwardly from the side walls of the outer container 10 serve both for centering the inner container, both for avoiding that the inner container floats upwardly to the surface of water when the outer container is filled up with cold water.

The infusion obtained with the apparatus of Nelsen is meant to be used in the preparation of "a markedly superior coffee brew, merely by measuring out the desired amount of the infusion and adding it to hot water" (col. 1 l. 14-17).

Moreover on column 3 lines 1-3 it is said that in order to obtain the infusion, 12-36 hours are required! An espresso beverage, like coffee or cappuccino is

obtained in less than one minute! Therefore Nelsen teaches to obtain a preparation which can be used for preparing a beverage in a successive moment. No person of skill in the art facing the problems addressed by this invention would even consider teachings from such a reference.

The outer container 10 of Nelsen cannot be pierced on the bottom, otherwise all the infusion would fall. The bottom 20 of Nelsen is sealed in order to close the container after the introduction of the inner container 22. Indeed, the inner container 22 can be introduced only from the open bottom because of the presence of the projections 24 and 26.

Therefore Nelsen does not teach to seal the bottom in order to temporarily close the container until its usage, but it teaches to seal to bottom in order to totally and permanently close the outer container!

In view of what above, the person of skill in the art would not consider Nelsen in order to combine it with Goros, because there are no suggestions or motivations to combine Nelsen with Goros or to modify Goros with the teachings of Nelsen.

Moreover, even if he considered Nelsen, he would not have any reasonable expectation of success combining Goros with Nelsen since they are not combinable.

Finally neither Goros nor Nelsen show all the teachings claimed.

Indeed, as regards claim 1, neither Goros, nor Nelsen show teach or suggest providing the capsule with a removable cover thus keeping in the aroma of the coffee and assuring more hygiene. Moreover a removable cover provides more effectiveness in melting coffee with water, since the entire surface of the

pod is in contact with hot water.

By contrast, Goros teaches that piercing means punch the upper section of the container in discrete points, pushing the outer closure inside the compartment containing coffee and allowing the introduction of water only in discrete points. Nelsen teaches to cut the outer container in order to introduce cold water.

Therefore, claim 1 is also inventive over the cited prior art.

Claim 22 is also inventive since neither Goros nor Nelsen show teach or suggest providing the bottom surface of the second container with a hole, covered by a seal of suitable material designed to be pierced when the capsule has to be used, and to re-close the hole when the capsule has already been used. When the capsule is inserted in the espresso machine, a needle pierces the seal and penetrates the hole in the capsule. In this way hot water can flow inside the capsule creating a flow of infused coffee. When the capsule is moved away from needle, the seal tends to re-close the hole, preventing residual water or beverage from dripping out and dirtying the user or the area around the machine. None of the prior art documents teaches or suggests such a solution.

The seal on the bottom of the outer container of Nelsen cannot be opened as already explained. Therefore, also combining Goros with Nelsen, there are no expectations of success.

Claim 23 is also inventive since neither Goros nor Nelsen show teach or suggest that the pod made of filter paper or other similar filter material has an annular outer edge fixed to a matching annular protuberance on the plastic cartridge, at the top of the cartridge itself.

By contrast Goros presents two superimposed compartments, separated by a porous disk attached to the inner walls of the container, while Nelsen show

an inner container which is not attached to the outer container at all.

Therefore there are no indications in Nelsen to modify Goros in order to obtain the claimed solution.

For the reasons stated above, independent claims 1, 22 and 23 are patentable over the cited prior art.

Applicant respectfully points out that since all the dependent claims 2-21 depend now directly and indirectly upon and contain all the limitation of patentable claim 1, they are patentable too.

In view of the foregoing, reconsideration and withdrawal of the above rejections is respectfully requested.

## **Conclusion**

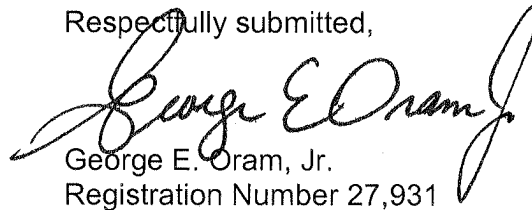
The prior art made of record but not applied by the Examiner has been carefully considered but is submitted to be less relevant than the references previously discussed.

All matters having been addressed above and in view of the pending claims and remarks, Applicant respectfully requests the entry of this Amendment, the Examiners reconsideration of the application, and the timely allowance of the pending claims.

Applicants counsel remains ready to assist the Examiner in any way to facilitate and expedite the prosecution of this application.

In the event that this paper is not being timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to Counsel's Deposit Account Number 01-2300, referencing Docket Number 023349-00298.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "George E. Oram, Jr.", written in a cursive style.

George E. Oram, Jr.  
Registration Number 27,931

Customer Number 004372  
ARENT FOX LLP  
1050 Connecticut Avenue, NW  
Suite 400  
Washington, DC 20036-5339  
Telephone: 202-857-6000  
Fax: 202-638-4810

GEO:vmh